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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,177	11/27/2000	Frederick W. Ryan JR.	F-211	3933

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PITNEY BOWES INC.
35 WATERVIEW DRIVE
P.O. BOX 3000
MSC 26-22
SHELTON, CT 06484-8000

EXAMINER	
BORISSOV, IGOR N	
ART UNIT	**PAPER NUMBER**
3639	

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/722,177	RYAN, FREDERICK W.	
	Examiner	Art Unit	
	Igor Borissov	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

IGOR N. BORISSOV
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Amendment received on 5/02/2006 is acknowledged and entered. Claims 17 and 25 have been amended. Claims 1-32 are currently pending in the application.

Claim Rejections - 35 USC § 112

Claim Rejections under35 USC § 112 have been withdrawn due to the applicant's amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 9-12, 17-20 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herbert (US 6,102,592) in view of Wright et al. (US 4,900,904).

Herbert teaches a method and apparatus for postage metering system, comprising:

Independent Claims

Claims 1 and 9,

a computer (Fig. 5, item 20);

a printer in operative communication with the computer, the printer Including an unsecure print head and a secure print head (Fig. 5, items 31 and 32; C. 1, L. 67 – C. 2, L. 7);

a control system in operative communication with the computer and the printer, the control system for executing a transaction session to generate postal data to be

included in a postal indicium, the postal indicium including non-authorization data (data to be printed with visible ink) (C. 2, L. 8-13);

initiating a print request to print the postal indicium (C. 2, L. 8-13);

controlling the unsecure print head to print the non-authorization data and the secure print head to print forensic evidence of the authenticity of the postal indicia, the forensic evidence being generated by the postage metering system (C. 2, L. 8-13; C. 3, L. 31-35).

Herbert does not specifically teach that said computer includes authentication unit functionality for executing said transaction session between a computer and the authentication unit to generate postal data to be included in the postal indicium.

Wright et al. (Wright) teaches an automated transaction system and method for a postage metering system operating in cooperation with a smart card, including the printer having a microprocessor unit (MPU) formed integrally with a print head, and a separate transaction printer; said MPU individually and uniquely controls the operation of the print head by executing an internal program which includes unique encryption algorithms parallel to those stored in the card's microprocessor, so that the printer MPU can execute a secure handshake recognition procedure with the card's microprocessor to authorize a requested transaction. With this arrangement the print head of the postage metering terminal can only be operated through the MPU, and will print a postmark only when the handshake recognition procedure and a postmark print command have been executed between the card MPU and the printer MPU (C. 2, L. 8-13; C. 8, L. 24-44).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Herbert to include that said computer includes authentication unit functionality for executing a transaction session between a computer and the authentication unit to generate postal data to be included in the postal indicium, as disclosed in Wright, because it would advantageously allow to prevent fraudulent transactions by incorporating a security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).

Claims 17 and 24. Said system and method, comprising:

a computer (Fig. 5, item 20);

a printer in operative communication with the computer, the printer including an unsecure print head and a secure print head (Fig. 5, items 31 and 32; C. 1, L. 67 – C. 2, L. 7);

a control system in operative communication with the computer and the printer, the control system for: executing a transaction session for generating document data to be included in a document, the document data including content data (data to be printed with visible ink) (C. 2, L. 8-13);

initiating a print request to print the document (C. 2, L. 8-13);

controlling the unsecure print head to print the content data and the secure print head to print forensic evidence of the authenticity of the document, the forensic evidence being generated by the postage metering system (C. 2, L. 8-13; C. 3, L. 31-35).

Herbert does not specifically teach an authentication unit in operative communication with the computer for executing said transaction session between a computer and the authentication unit to generate postal data to be included in the postal indicium.

Wright et al. (Wright) teaches an automated transaction system and method for a postage metering system operating in cooperation with a smart card, including the printer having a microprocessor unit (MPU) formed integrally with a print head, and a separate transaction printer; said MPU individually and uniquely controls the operation of the print head by executing an internal program which includes unique encryption algorithms parallel to those stored in the card's microprocessor, so that the printer MPU can execute a secure handshake recognition procedure with the card's microprocessor to authorize a requested transaction. With this arrangement the print head of the postage metering terminal can only be operated through the MPU, and will print a postmark only when the handshake recognition procedure and a postmark print

command have been executed between the card MPU and the printer MPU (C. 4, L. 58-59; C. 8, L. 24-44).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Herbert to include an authentication unit in operative communication with the computer for executing a transaction session between a computer and the authentication unit to generate postal data to be included in the postal indicium, as disclosed in Wright, because it would advantageously allow to prevent fraudulent transactions by incorporating a security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).

Dependent Claims

Claims 2, 10, 18 and 26. Wright teacahes said method and system, wherein: the postal indicium further includes authorization data; and the forensic evidence of the authenticity of the postal indicia is the authorization data (the identification number of the terminal which has authorized the transaction) (C. 4, L. 67). The motivation to combine references would be to prevent fraudulent transactions by incorporating a security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).

Claims 3, 11, 19 and 27. Wright teacahes said method and system, wherein: the control-system is further for preventing printing by the unsecure print head until an appropriate signal is generated by the secure print head (C. 8, L. 33-35). The motivation to combine references would be to prevent fraudulent transactions by incorporating a security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).

Claims 4, 12, 20 and 28. Wright teacahes said method and system, wherein: the control system is further for initiating a mutual authentication routine between the secure

print head and the authentication unit; and preventing printing by the secure print head if the mutual authentication is unsuccessful (C. 8, L. 24-44). The motivation to combine references would be to prevent fraudulent transactions by incorporating a security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).

Claims 5-8, 13-16, 21-24 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herbert in view of Wright et al. and further in view of Windel et al. (US 5,991,409).

Claims 5, 13, 21 and 29. Herbert in view of Wright teaches all the limitations of Claims 5, 13, 21 and 29, including that forensic evidence of the authenticity of the postal indicia is a unique print pattern (the identification number of the terminal which has authorized the transaction) (Wright; C. 4, L. 67), except specifically teaching that the postal indicium further includes authorization data printed by the unsecure print head.

Windel et al. (Windel teaches a postage meter system and method for generating and printing a security imprint, including a "secure" print head for printing encoded information (C. 8, L. 4-20), and a separate printer for printing a serial number of the postage meter machine (which has authorized the transaction), said serial number is printed unencoded (C. 15, L. 11-16).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Herbert and Wright to include that the postal indicium further includes authorization data printed by the unsecure print head, because it would advantageously allow to reduce the outlay for checking mailings by allowing a directed, machine check of specific senders, or of their postage meter machines (Windel; C. 15, L. 19-25).

Claims 6, 14, 22 and 30. Windel teaches said method and system, wherein: the unique print pattern is a tell (mark) that is embedded within the postal indicium (C. 8, L.

4-20). The motivation to combine references would be to prevent fraudulent transactions.

Claims 7, 15, 23 and 31. Wright teaches said method and system, wherein: the control system is further for preventing printing by the unsecure print head until an appropriate signal is generated by the secure print head (C. 8, L. 33-35). The motivation to combine references would be to prevent fraudulent transactions by incorporating a security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).

Claims 8, 16, 24 and 32. Wright teaches said method and system, wherein: the control system is further for initiating a mutual authentication routine between the secure print head and the authentication unit; and preventing printing by the secure print head if the mutual authentication is unsuccessful (C. 8, L. 24-44). The motivation to combine references would be to prevent fraudulent transactions by incorporating a security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).

Response to Arguments

Applicant's arguments filed 5/02/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that Herbert fails to disclose "a computer," it is noted that Herbert explicitly teaches said feature. Specifically, Herbert teaches a micro-processor 20 operating under program routines stored in a read only memory (Fig. 5; C. 4, L. 20-22).

In response to applicant's argument that Herbert fails to disclose "a control system because the control system is in operative communication with the computer, authentication unit and the printer," Examiner points out that Herbert teaches a micro-

processor 20 operating under program routines stored in a read only memory (Fig. 5; C. 4, L. 20-22). As per "authentication unit" functionality, Herbert does not specifically teach that said computer includes authentication unit functionality for executing said transaction session between a computer and the authentication unit to generate postal data to be included in the postal indicium. Specifically, Wright teaches a microprocessor unit (MPU) formed integrally with a print head, and a separate transaction printer; said MPU individually and uniquely controls the operation of the print head by executing an internal program which includes unique encryption algorithms (C. 2, L. 8-13; C. 8, L. 24-44).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references relate to controlling a printing process. The motivation to combine the references would be to advantageously prevent fraudulent transactions by incorporating a security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB
7/10/2006

IGOR N. BORISSOV
PRIMARY EXAMINER